

Examiner's Response to Arguments

The Examiner first notes that Applicants' arguments were considered but are moot in view of the new grounds of rejection. Applicants note with appreciation the Examiner's conclusion that the currently pending claims were allowable over the prior art combination of Jimenez and Wu.

Claims 57 to 62

Notwithstanding the new rejections, the Examiner does note that Applicants incorrectly referred to Jimenez instead of Davis (U.S. Patent No. 5,796,952) when contesting the propriety of the combination of references used to reject Claims 57-62. Applicants respectfully submit that the same remarks made with respect to the combination of Jimenez and Wu apply equally to the combination of Wu and Davis, namely, that there is no suggestion to combine the teachings of Wu and Davis and that the mere advantageous nature of something in hindsight as stated by the Examiner does not suggest such combination. For the same reasons the Examiner accepted the Applicants' refutation of Jimenez and Wu, the Applicants submit that the refutation of Wu and Davis, and Wu, Davis, and Hickman, rejections be accepted as well.

Similarly, despite the new ground of rejection, the Examiner reiterates the status of Wu as a valid reference, relying on the priority date of the provisional application. As the Wu reference is being maintained as a rejection of certain of the claims, Applicants respectfully maintain their position of the Wu reference as being unsuitable as prior art in the manner presented by the Examiner. More particularly, the Examiner did not reference any portion of the provisional application that teaches or suggests any portion of the claims recited by the Applicants. The priority date relied upon by the Examiner is only applicable to those portions of the specification included in the provisional filing. While the Applicants do not believe the specification of the utility application discloses, teaches, or suggests certain elements of Claims 57 to 62 in the manner suggested by the Examiner, even when taken in view of Logan, the Applicants respectfully submit that the provisional application certainly does not disclose, teach, or suggest the elements in the manner suggested by the Examiner, much less provide any teaching or suggestion to combine its limited teachings with either Davis, Hickman, or Logan. Thus, a prima facie case of obviousness based on the teaching of the provisional application has not been

established. For at least these reasons, Applicants respectfully submit that each of the prior and current rejections of Claims 57 through 62 using Wu are improper.

Rejections Under 35 U.S.C. § 103:

Claims 1-56 are newly rejected under 35 U.S.C. 103(a) as being anticipated over U.S. Pub. No. 2001/0048676 to Jimenez ("Jimenez") in view of U.S. Patent No. 6,199,076 to Logan ("Logan"). Claims 57-62 are newly rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Jimenez, et al. Reconsideration and favorable action are requested.

Claim 1

With regard to Claim 1, the Examiner asserts that paragraph [0008] of Jimenez teaches the conversion of Web content from a text-based format to an audio format. In fact, such paragraph discloses something more similar (although not equivalent) to the opposite, namely the conversion of telephony (not Web content) into Internet Protocol (Web content), and then converting audio portions of such internet protocol into text equivalent signals.

Further with regard to Claim 1, the Examiner asserts that the same paragraph [0008] teaches serving the Web content in an audio format to a user device via telephone link with the client device. In fact, paragraph 8 describes something more similar to the opposite, namely establishing a call from a client device and sending audio data FROM such client device TO the Internet.

Further with regard to Claim 1, the Examiner asserts that paragraphs [0050] and [0054] teach "means, responsive to a user request via the client device for Web content, for retrieving an

advertisement” and “means for inserting the retrieved advertisement with the use requested Web content.” In fact, paragraph 50 discloses the presentation of menu options to forward various portions of audio previously listened to by the user. Paragraph 54 discloses one of the recipients to which audio has been forwarded by the user in paragraph 50 electing to retrieve the audio (if they have a multimedia PC). While Paragraph 54 does mention that advertisements may be linked to the audio content, there is nothing in either Jimenez or Logan to suggest that such advertisements can be converted to audio. In fact, Paragraph 54 assumes that such content is being accessed using a multimedia personal computer, and does not suggest that such communication would be over a telephone line.

The Examiner admits that Jimenez does not disclose conversion of an advertisement into an audio format or an advertisement server. Nevertheless, the Examiner suggests that Logan’s system for playing audio programming somehow teaches that such elements be used in combination with the elements of Jimenez. Even if the elements said to be suggested by Jimenez were in fact suggested by Jimenez, the stated combination of references does not teach the unique combinations recited by Claim 1.

For example, the Examiner asserts that Logan discloses “means for forwarding the user requested Web content and advertisement to the text-to-speech transcoder for conversion to an audio format.” However, the cited portions of Logan disclose only recognition of the fact that text can be converted into audio form [Column 6, lines 6 to 25], downloading web content generally [Column 6, lines 62 to 67], and determining the type and amount of advertisements based on content and cost parameters selected by a subscriber [Column 10, line 44 to Column 11,

line 3; Column 11, lines 34 to 37]. Interestingly enough, while the text within these four disparate sections of Logan contain most of the words and phrases included in this element of Claim 1, nothing in Logan ties the words and phrases together to suggest "means for forwarding the user requested Web content and advertisement to the text-to-speech transcoder for conversion to an audio format." In fact, the disparate portions of Logan employed by the Examiner itself suggests that those reviewing Logan at the time of its filing would not have come up with a suggestion of this element of Claim 1.

Next the Examiner states that Logan suggests an advertisement server in the manner recited by Claim 1. However, the cited portion of Logan does not disclose an advertisement server. The cited portion of Logan does not even mention the word advertisement on any similar term. Applicants' fail to see how a web server teaches the concept of an advertisement server, much less one used in the manner recited by Claim 1.

With regard to fulfilling the prima facie obligation of a suggestion to combine the teachings of Jimenez and Logan, the Examiner cites only an object of Logan [Column 1, line 66 to Column 2, line 3] that states that such object is to provide easy access to audio content "without the need of a visual display screen." Applicants fail to see how such statement suggests the combination of Logan teachings with any of the teachings of Jimenez, much less all of those used to reject various elements of Claim 1. Instead, Applicants believe the Examiner is using impermissible hindsight, both to combine separate portions of Logan that have appropriate key words in the wrong context, and to combine such portions of Logan with Jimenez to build a rejection of Claim 1 that does not consider the unique combination of elements recited therein.

For at least these reasons, Applicants respectfully submit that the rejection of Claim 1 was improper and that the cited combination of Jimenez and Logan do not disclose, teach, or suggest the unique combination of references recited in Claim 1. As Claims 2 through 8 depend from Claim 1, Applicants respectfully submit that such claims are also allowable.

Claim 9

With regard to Claim 9, the Examiner asserts that it has substantially the same limitations as Claim 1. Applicants, however, respectfully note that Claim 9 is substantially different from Claim 1. However, Applicants reiterate each of their remarks referencing the Examiner's rejection of Claim 1 and submit that the cited portions of Jimenez and Logan are even more inapplicable to the unique combination of elements recited by Claim 9.

The Examiner also asserts that Logan discloses "means for notifying the advertisement server of user interaction with an advertisement" [Column 28, lines 6 to 65]. Most of the cited portion [lines 6 to 57] is irrelevant to anything to do with advertisements. Instead, it refers to tracking featured audio content played by a subscriber and how to manage subscriber billing for such content. Obviously, the subscribers are not billed for viewing advertisements. The last eight lines do refer to keeping track of the number of times an advertisement was played so the advertiser can ensure they are being billed correctly. It also suggests that demographic data regarding subscribers can be provided to the advertiser. Neither of such statements suggest "notifying [an] advertisement server of user interaction with an advertisement."

The Examiner further asserts that it would have been obvious "to incorporate Logan's billing and advertisement functionality into Jimenez to insure that billing is accurate and based on the viewing of advertisements of the users." Applicants' respectfully submit that advertisement functionality has nothing to do with billing being accurate. Further, one again, the desirability of something, particularly when considered in hindsight, is not a suggestion to combine the teachings of Logan with a system like Jimenez.

For at least the foregoing reasons Applicants respectfully submit that Claim 9 is allowable over the cited combination of Jimenez and Logan. As Claims 10 through 19 depend from Claim 9, Applicants respectfully submit that Claims 10 through 19 are allowable as well.

Claims 20, 27, 39, and 46

With regard to Claims 20, 27, 39, and 46, the Examiner merely states that they are similarly suggested for at least the reasons set forth for Claims 1 and 9. Applicants respectfully submit that Claims 20, 27, 39, and 46 are not identical to Claims 1 and 9 and that a prima facie case of obviousness has not been made with respect to any of such claims. Further, Applicants reiterate each of the remarks set forth above with respect to Claims 1 and 9. The stated combination of Jimenez and Logan does not disclose, teach, or suggest the unique combination of elements recited by Claims 20, 27, 39, and 46, and there is no express or implied suggestion to combine the teaching of Jimenez and Logan in the manner previous suggested by the Examiner. A statement that something can be accomplished without a visual display does nothing to suggest the unique combination of references recited by Claims 20, 27, 39, and 26. For at least these reasons, Applicants respectfully submit that Claims 20, 27, 39, and 46 are allowable over the

recited prior art. As Claims 21-26, 28-38, 40-45, and 47-56 depend from Claims 20, 27, 39, and 46 respectively, Applicants respectfully submit that such claims are also allowable.

Claim 57

In addition to Applicants' remarks noted above with respect to Claim 57, Applicant further notes that the Examiner asserts that Logan discloses an advertisement server. As noted above, Logan does not disclose an advertisement server. The Examiner further asserts that Logan discloses "means for selecting an advertisement for insertion within Web content requested by a user via a client device in communication with a Web server, wherein the advertisement has a text-based format and is configured to be interactive when converted to an audio format" [citing Figure 1, item 130; Column 6, lines 22-27 and 38-50; where item 130 represents and advertising server]. Item 130 is a program data library. Column 6, on lines 22-27 and lines 38-50, does not disclose this recited element or even the more discrete concepts of text to audio conversion, much less anything regarding advertisements, much less an advertisement configured to be interactive when converted to an audio format. Likewise, Logan's disclosure of playback options on Column 27, line 41 to Column 28, line 5 does not disclose "means for receiving notification from a text-to-speech transcoder that the selected advertisement has been delivered to the user client in an audio format."

The Examiner admits that Logan does not disclose means for forwarding a selected advertisement to a Web server for insertion within the Web content requested by a user. The Examiner then asserts that Jimenez teaches such means by disclosing item 120. However, it appears item 120 is an audio browser. The Examiner does not assert how such audio browser would, and Applicants respectfully submit that such audio browser does not, disclose, teach, or

suggest the recited element of Claim 57. Further, once again, no suggestion to combine the teachings of Jimenez and Logan is presented by the Examiner with regard to the elements of Claim 57 other than statements that it would have been obvious and that there is no patentable distinction, neither of which satisfy the prima facie burden of an implied or express suggestion to combine. Further, to the Examiner's statement of there being no patentable distinction between implementing functionality at a client or server level, Applicants do not understand the relevance of such an asserted conclusion to Claim 57. Further, even if such a conclusion were relevant, Applicants respectfully submit that such conclusion is incorrect, as the decision of establishing functionality at a server or client level is one of the quintessential issues impacting how networks are architected, particularly for thin client applications used in handheld wireless devices, and can affect issues such as bandwidth, quality of service, redundancy, scalability, portability, memory, form factors, power consumption, roaming capabilities, and network gateway design.

For at least these reasons, Applicants respectfully submit that Claim 57 is allowable over the cited prior art. As Claims 58-62 depend from Claim 57, Applicants respectfully submit that such claims are also allowable.